



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,822	04/02/2001	Shinichi Baba	04900.00001	8088

22907 7590 09/15/2004

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

JONES, PRENELL P

ART UNIT	PAPER NUMBER
----------	--------------

2667

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,822

Applicant(s)

BABA ET AL.

Examiner

Prenell P Jones

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/02/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 and 16-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15 and 22-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4 & 6.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 7.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Group I, Claims 1-8, 15 and 22-35, drawn to a soft hand-off system incorporating IP-in-IP encapsulation between two nodes, classified in class 370, subclass, 312, 331-338, 342, 352, 432, 466 and 509.
 - II. Group II, Claims 9-14 and 16-21, drawn to a base station encapsulating packets with headers and transmitting them to a second base station, classified in class 370, subclass 389-396.

1. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I and visa versa, restriction for examination purposes as indicated is proper.

Inventions I and II are related as combination and sub-combinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombinations as claimed for patentability, and (2) that the subcombinations has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I consist of a

2. Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each

Art Unit: 2667

other if they are shown to be separately usable. In the instant case, invention Group I and Group II has separate utility such as See MPEP § 806.05(d).

3. During a telephone conversation with Applicant Representative, Mr. Christopher Glembocki on September 3, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8, 15 and 22-35. Affirmation of election must be made by Applicant in replying to this Office action. Claims 9-14 and 16-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 9-14 and 16-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. ***The form and legal phraseology*** often used in patent claims, such as "means" and "said," ***should be avoided***. The

Art Unit: 2667

abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5. Claims 1, 2, 15 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahmed et al.

Regarding claims 1, 2, 15 and 22, Ahmed discloses (Abstract, col. 6, line 44-67, col. 18, line 21 thru col. 20, line 63, col. 22, line 47 thru 23, line 11, col. col. 24, line 11-20) a CDMA IP based multimedia mobile network wherein the architecture communication between nodes (first/second base station), transferring/processing packets associated with an IP network, utilizing IP-in-IP, IP tunneling, utilizing soft handoffs in CDMA system, replacing/stripping IP header prior to forwarding data packet, (col. 35, line 49-61), (col. 18, line 21-38) soft handoffs provide mobiles direct communication with multiple nodes simultaneously, and encapsulating original data packet in IP header.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-8 and 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmed et al in view of Ahmed et al in view of La Porta et al.

Regarding claims 3-8 and 23-35, Ahmed discloses (Abstract, col. 6, line 44-67, col. 18, line 21 thru col. 20, line 63, col. 22, line 47 thru 23, line 11, col. col. 24, line 11-20) a CDMA IP based multimedia mobile network wherein the architecture communication between nodes (first/second base station), transferring/processing packets associated

Art Unit: 2667

with an IP network, utilizing IP-in-IP, IP tunneling, utilizing soft handoffs in CDMA system, replacing/stripping IP header prior to forwarding data packet, (col. 35, line 49-61), (col. 18, line 21-38) soft handoffs provide mobiles direct communication with multiple nodes simultaneously, and encapsulating original data packet in IP header. Ahmed is silent on creating and transmitting new headers between communicating nodes. In analogous art, La Porta discloses (Abstract, Figs. 3 thru 6, col. 1, line 38 thru col. 2, line 49, col. 4, line 16 thru col. 5, line 64, col. 33, line 33 thru col. 34, line 67) packet tunneling associated with a CDMA wireless mobile communication system wherein the utilization of encapsulating header addresses is provided and IP packet header are encapsulated for tunneling purposes, encapsulation of packets in an IP-in-IP tunnel to foreign agents, whereby the architecture includes host based routers used to interface between base stations for communicating packet data, encapsulated packets are forwarded via handoffs from an old base station foreign agent (first base station) to a new base station foreign agent (second base station), and (Figs. 19-24, col. 33, line 8 thru col. 36, line 67) new IP header is created and forwarded between communicating nodes. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement creating and forwarding new headers as taught by La Porta's mobile communicating system with the teachings of Ahmed's mobile communicating system for the purpose of further managing tunneling/encapsulation methods as associated with increasing packet flow, decreasing overhead and communicating coherent data packets between nodes in a CDMA IP-based communication system.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prenell P. Jones whose telephone number is 571-272-3180. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prenell P. Jones

September 2, 2004


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 9/7/04